REMARKS

Forty-two claims were originally filed in the present Application, and claims 43-57 were subsequently added by amendment. Claims 1-19, 21-39, and 41-42 have been canceled, and claims 20, 40, and 43-57 currently stand rejected. Claims 20, 40, 43, and 46 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

35 U.S.C. § 102(e)

In paragraph 5 of the Office Action, the Examiner rejects claims 43, 44, and 54 under 35 U.S.C. § 102(e) as being anticipated by over U.S. Patent No. 5,940,073 to Klosterman et al. (hereafter Klosterman). The Applicants respectfully traverse these rejections for at least the following reasons.

"For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference." *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicant submits that Klosterman fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Regarding the Examiner's rejection of independent claim 43, Applicant responds to the Examiner's §102 rejection as if applied to amended independent claim 43 which is now amended to recite *"said video window displaying a video program currently in progress,"* which are limitations that are not taught or suggested either by the cited references, or by the Examiner's citations thereto.

Klosterman teaches a system that "provides a program schedule guide with information regions for displaying additional information." The foregoing information regions may be "used for displaying advertising or promotional messages . . . ." (column 1, lines 52-53). However, unlike Applicant's claimed invention, Klosterman nowhere teaches downloading "Internet page data". In addition, Klosterman fails to disclose inserting video into a video window to display "*a video program currently in progress*" as claimed by Applicant. Furthermore, Klosterman teaches scrolling the inserted window (information regions), which is the opposite of Applicant's scrolling of the background Internet page data.

On page 6 of the Office Action, the Examiner states with regard to Klosterman that "the page data comprises video window 688 for displaying video from video source." Applicant respectfully disagrees. Applicant submits that the window disclosed by Klosterman does not display a moving "video program currently in progress" as claimed by Applicant. In contrast, the window 688 taught by Klosterman is still image data that only "shows the television program that the user was viewing before the user selected . . . from program guide screen 600."

The purpose of window 688 taught by Klosterman is also significantly different from the "video window" claimed by Applicant. Klosterman teaches that "[t]he user may resume watching the television program by clicking on window 688. This is referred as "*hypertuning*," and the system will return to the program that the user was viewing." Applicant therefore submits that the claimed "video

data" and the "video window" are not anticipated by the teachings of Klosterman, and the rejections over Klosterman are therefore improper.

Regarding the Examiner's rejection of dependent claims 44 and 54, for at least the reasons that these claims are directly or indirectly dependent from independent claim 43 whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of independent claim 43, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 44 and 54 so that these claims may issue in a timely manner.

Furthermore, with regard to claim 44, the Examiner states "[n]ecessarily, the format manager positions a video tag (for video window 688) to vertically location the video window . . . ." Applicant respectfully submits that the cited reference fails to mention or disclose positioning "a video tag to vertically locate said video window on said display device in relation to a current reference position on said display device," as claimed by Applicant.

Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Klosterman to identically teach or suggest the claimed invention, Applicants respectfully request reconsideration and allowance of claims 43, 44, and 54, so that these claims may issue in a timely manner.

35 U.S.C. § 103

In paragraph 7 of the Office Action, the Examiner rejects claims 49, 53, and 55 under 35 U.S.C. § 103 as being unpatentable over Klosterman. The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

> "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 49, 53, and 55, for at least the reasons that these claims are directly or indirectly dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claims 49, 53, and 55, so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicant submits that claims 49, 53, and 55 are not unpatentable under 35 U.S.C. § 103 over Klosterman, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 20, 40, 43-47, 49, and 53-54 under 35 U.S.C. § 103.

In paragraph 8 of the Office Action, the Examiner rejects claim 45 under 35 U.S.C. § 103 as being unpatentable over Klosterman in view of U.S. Patent No. 6,184,878 to Alonso et al. (hereafter Alonso). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations. The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claim 45, for at least the reasons that this claim is dependent from an independent claim 43 whose limitations are not identically taught or suggested, the limitations of dependent claim 45, when viewed through or in combination with the limitations of the independent claim 43, are also not identically taught or suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claim 45, so that this claim may issue in a timely manner.

Further with regard to claim 45, Applicant submits that neither Klosterman nor Alonso disclose utilizing a video tag to vertically position a video window within duplicated Internet page data. Applicant respectfully requests the Examiner to provide a specific citation to either of the cited references to support the rejection of "positioning said video tag within said duplicate Internet page data to vertically position said video window." Alternately, Applicants request the Examiner to reconsider and allow rejected claim 45.

For at least the foregoing reasons, the Applicant submits that claim 45 is not unpatentable under 35 U.S.C. § 103 over Klosterman in light of Alonso, and that the rejection under 35 U.S.C. § 103 is thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claim 45 under 35 U.S.C. § 103.

In paragraph 9 of the Office Action, the Examiner rejects claim 46 and 47 under 35 U.S.C. § 103 as being unpatentable over Klosterman in view of U.S. Patent No. 6,157,381 to Bates et al. (hereafter Bates). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations. The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claim 46, Applicant responds to the Examiner's §103 rejection as if applied to amended claim 46 which is amended to recite that *"said format manager recomputes said current reference position each time said Internet page data is scrolled on said display device in relation to said video window to maintain said video window in a stationary position on said display device,"* which are limitations that are not taught or suggested either by the cited references, or by the Examiner's citations thereto.

With regard to claim 46, the Applicant submits that Klosterman fails to teach scrolling page data of the background document, but rather teaches scrolling of information within the "information regions" (see column 2, lines 1-2). The foregoing technique is the reverse of that taught by Applicant. In addition, Bates essentially teaches a "non-linear scroll bar" for varying a relative scrolling rate of a portion of a document" (see column 2, lines 20-55). Applicant submits that Bates fails to teach a "current reference position" that is computed by "combining a prior reference position and a scroll value," as claimed by Applicant.

Furthermore, Applicant submits that Bates fails to teach utilizing a "video tag" and a "current reference value" to "maintain said video window in a stationary position" on a display device, as claimed by Applicant. Claim 47 depends upon claim 46 and is allowable for at least the same reasons.

Therefore, for at least the foregoing reasons, the Applicant submits that claims 46 and 47 are not unpatentable under 35 U.S.C. § 103 over Klosterman in light of Bates, and that the rejections under 35 U.S.C. § 103 are thus improper.

The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claim 46 and 47 under 35 U.S.C. § 103.

In paragraph 10 of the Office Action, the Examiner rejects claim 20 and 40 under 35 U.S.C. § 103 as being unpatentable over Klosterman in view of Alonso and further in view of Bates. The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations. The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of independent claims 20 and 40, Applicant responds to the Examiner's §102 rejection as if applied to amended independent claims 20 and 40 which now recites *"said video window displaying a video program currently in progress,"* which are limitations that are not taught or suggested either by the cited references, or by the Examiner's citations thereto.

On page 13 of the Office Action, the Examiner states with regard to Klosterman that "[w]eb page 680 comprises window 688 . . . ." Applicant submits that the window disclosed by Klosterman does not display a moving "video program currently in progress" as claimed by Applicant in claims 20 and 40. In contrast, the window 688 taught by Klosterman is still image data that only

"shows the television program that the user was viewing before the user selected . . . from program guide screen 600."

The purpose of window 688 taught by Klosterman is also significantly different from the "video window" claimed by Applicant. Klosterman states that "[t]he user may resume watching the television program by clicking on window 688. This is referred as "*hypertuning*," and the system will return to the program that the user was viewing." Applicant therefore submits that the claimed "video data" and the "video window" are not anticipated by the teachings of Klosterman, and the rejections over Klosterman are therefore improper.

For at least the foregoing reasons, the Applicant submits that claims 20 and 40 are not unpatentable under 35 U.S.C. § 103 over Klosterman in light of Alonso and Bates, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 20 and 40 under 35 U.S.C. § 103.

In paragraph 11 of the Office Action, the Examiner rejects claim 48 under 35 U.S.C. § 103 as being unpatentable over Klosterman in view of U.S. Patent No. 5,940,073 to Judson et al. (hereafter Judson). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim

limitations. The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claim 48, for at least the reasons that this claim is dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claim 48, so that this claim may issue in a timely manner.

Furthermore, in the rejection of claim 48, the Examiner concedes that "Klosterman does not specifically disclose the video tag includes a video source parameter . . . ." Applicant concurs. The Examiner then points to Judson to purportedly remedy this deficiency. Judson teaches "the display of some useful information to the user during the period of user "download" time . . . ." (column 1, lines 60-63). Applicant respectfully disagrees with the Examiner's interpretation of Judson.

The Examiner cites Figures 5-8 and column 1, lines 60+ of Judson against Applicant's claimed "video source parameter". Applicant submits that column 1, lines 60+ of Judson completely fails to discuss any sort of "video source parameter" implemented as part of a "video tag", as claimed by Applicant. Furthermore, Applicant respectfully submits that the "PTO seal" disclosed in Figures 5-8 of Judson is not a "video source parameter" because

it fails to disclose the specific location/source of corresponding video data.

For at least the foregoing reasons, the Applicant submits that claim 48 is not unpatentable under 35 U.S.C. § 103 over Kosterman in view of Judson, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claim 48 under 35 U.S.C. § 103.

In paragraph 12 of the Office Action, the Examiner rejects claims 50-52 under 35 U.S.C. § 103 as being unpatentable over Klosterman in view of U.S. Patent No. 5,844,620 to Coleman et al. (hereafter Coleman). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations. The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicant respectfully traverses the Examiner's assertion that modification of the device of Klosterman according to the teachings of Coleman would produce the claimed invention. Applicant submits that Klosterman in combination with Coleman fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicant also submits that neither Klosterman nor Coleman contain teachings for combining the cited references to produce the

Applicant's claimed invention. The Applicant therefore respectfully submits that the obviousness rejections under 35 U.S.C §103 are improper.

Regarding the Examiner's rejection of dependent claims 50-52, for at least the reasons that these claims are directly or indirectly dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claims 50-52, so that these claims may issue in a timely manner.

Furthermore, in the rejection of claims 50-52, the Examiner concedes that "Klosterman does not specifically disclose automatically reformats (sic) text data and graphics data from the page data . . . ." Applicant concurs. The Examiner then points to Coleman to purportedly remedy this deficiency. Applicant respectfully disagrees with this interpretation of Coleman.

Coleman teaches that "an existing [television] program can be reformatted when the program guide is displayed in a partial screen mode." (column 3, lines 19-21). Coleman therefore teaches reformatting video programming. Applicant respectfully submits that the reformatting process of Coleman is therefore the opposite of Applicant's reformatting of Internet page data while maintaining the inserted video data without any reformatting procedure.

For at least the foregoing reasons, the Applicant submits that claims are not unpatentable under 35 U.S.C. § 103 over Kosterman in view of Coleman, and

that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 50-52 under 35 U.S.C. § 103.

In paragraph 13 of the Office Action, the Examiner rejects claims 56 and 57 under 35 U.S.C. § 103 as being unpatentable over Klosterman in view of Alonso and further in view of Judson. The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations. The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

With regard to claim 56, the foregoing arguments made above with regard to independent claims 20, 40, and 43 apply equally, and are hereby incorporated by reference. In addition, Applicant submits that the cited references fail to teach or disclose a "video source parameter to indicate a source memory-location of said video data for inserting into said video window" as recited by Applicant in independent claim 56.

With regard to dependent claim 57, Applicant submits that the cited references nowhere disclose a format manager that "automatically reformats text data and graphics data from said Internet page data to optimally utilize a

remaining area of said display device that is not utilized to display said video window, said format manager automatically reformatting said text data and said graphics data from said Internet page data to avoid said video window while maximizing an amount of said text data and said graphics data displayed on said display device."

For at least the foregoing reasons, the Applicant submits that claims are not unpatentable under 35 U.S.C. § 103 over Klosterman in view of Alonso and Judson, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 56 and 57 under 35 U.S.C. § 103.

Summary

Applicant submits that the foregoing amendments and remarks overcome the Examiner's rejections of claims 20, 40, and 43-57. Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicant therefore submits that the claimed invention is patentable over the cited art, and respectfully requests the Examiner to allow claims 20, 40, and 43-57 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicant's undersigned representative at the number provided below.

Respectfully submitted,

Date: 8/10/04

By: _____

Gregory J. Koerner, Reg. No. 38,519
SIMON & KOERNER LLP
10052 Pasadena Avenue, Suite B
Cupertino, CA 95014
(408) 873-3943